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DILLION & YUDELL LLP
8911 NORHT CAPITAL OF TEXAS HIGHWAY
SUITE 2110
AUSTIN, TX 78759

EXAMINER	
HANNE, SARA M	

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/042,047
Filing Date: January 08, 2002
Appellant(s): COLSON ET AL.

James E. Boice
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 12/15/06 appealing from the Office action mailed 8/24/06.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

20040107356	Shamoon et al.	6-2004
6593944	Nicolas	7-2003
6701350	Mitchell	3-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 6, 12 and 18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to support a "agreement to pay a fee" for display of "only a non-text image". If the term "non-text" is inclusive in the definition of image, then the recitation of "non-text" in the claims is repetitive. However the examiner feels that "non-text" is further limiting the claims. There may be an image of text, for example in the case of a screen shot. The specification does not teach distinguishing an image from a non-text image, and

therefore it is unclear what the intent is of this limitation. The examiner encourages the attorney to call to discuss this matter if it is still unclear why this rejection still stands.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-9, 13-15, 19-22, 25-30, 33-38 and 41-42 rejected under 35 U.S.C. 102(e) as being anticipated by Shamoon et al., US Patent Appliation Publication 2004/0107356, hereinafter Shamoon.

As in Claims 1, 7, 13, 19, 27 and 35, Shamoon teaches a method, system and computer program product for requesting, from a user device and via a billing server (Par. 320, 329, 443) a single web page's content from a network content server (Par. 311, 386), displaying on the user device multiple options from the billing server to a single user of the user device to view the single web page's content for a price (Par. 475), wherein each option has a different price (Shamoom teaches display for free, zero dollars, or for a price, X dollars) selecting, by the single user at the user device, an option (Par. 476), receiving, at the user device, a requested content from the single web page according to the selected option wherein the requested content is less than all of

the single web page (Par. 358 and 468) and displaying on the user device the requested content from the single web page (Par. 475, 476, and example in Par. 522).

As for Claims 2, 8, 14, 20, 28 and 36, Shamoon teaches prices of options based on removal of an advertisement from the single web page content (Par. 475 et seq.).

As in Claims 3, 9, 15, 21, 29, and 37, Shamoon teaches the price of the option based on an age of the web page content (Par. 287, the length of time the content is displayed is the age).

As in Claims 22, 30 and 38, Shamoon teaches multiple offers are defined by a non-URL descriptive portion of a script header to the web page content (Par. 454 et seq. and Figures 2, 7 with corresponding text).

As in Claims 25, 33 and 41, Shamoon teaches the network content server is on the Internet (Par. 311).

As in Claims 26, 34 and 42, Shamoon teaches the billing server and the network content server are a same device (Par. 352 and 443).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

As in Claims 4-6, 10-12, 16-18, 24, 32 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamoon et al., US Patent Application Publication 2004/0107356, and further in view of Nicolas et al., US Patent 6593944, hereinafter Nicolas.

As in Claims 4, 10, 16, 24, 32 and 40, Shamoon discloses requesting a single web page, displaying differently priced options pertaining to a portion of the single web page, selecting an option, retrieving and displaying the corresponding portion of the single web page (See Claim 1 rejection *supra*) and the appliance which displays the web page to be "any computing device" such as a PC (Par. 247). Shamoon fails to clearly teach web page content displayed on a PDA as recited in the claims. In the same field of the invention, Nicolas teaches a web page display mechanism similar to that of Shamoon. Nicolas further teaches the client receiving the web page on a PDA (Col. 5, lines 60 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Shamoon and Nicolas before him at the time the invention was made, to modify the requesting of a single web page, displaying differently priced options pertaining to a portion of the single web page, selecting an option, retrieving and displaying the corresponding portion of the single web page taught by Shamoon to include the PDA implementation of Nicolas, in order to obtain PDA access and retrieval of portions of a webpage selectable according to pricing options. One would have been motivated to make such a combination because a a billable Internet interface to optionally charge for web page access for minimizing the amount of data presented due

to limited space would have been obtained, as taught by Nicolas (Col. 1, line 53 et seq.).

Furthermore as in Claims 5, 11, 17, Shamoon teaches the prices of the option are based on what percentage of the single web page is displayed on the user device (100% with adverstising, less than 100% without advertising). Shamoon fails to teach web page content displayed on a PDA wherein a choice of what percentage of the single page is displayed is dependent on the size of the PDA's limited sized display as recited in the claims. In the same field of the invention, Nicolas teaches a web page display mechanism similar to that of Shamoon. In addition, Nicolas further teaches the web page content displayed on a PDA wherein a choice of what percentage of the single page is displayed is dependent on the size of the PDA's limited sized display (Col. 2, line 40 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Shamoon before him at the time the invention was made, to modify the requesting of a single web page, displaying differently priced options pertaining to a portion of the single web page, selecting an option, retrieving and displaying the corresponding portion of the single web page taught by Shamoon to include the choice of what percentage of the single page is displayed is dependent on the size of the PDA's limited sized display of Nicolas, in order to obtain user selection, according to display size, of a different priced options, priced according of percentage of the web page displayed. One would have been motivated to make such a combination because user customizable interface for web page viewing on small display screens would have been obtained, as taught by Nicolas (Col. 2, lines 15-31).

As in Claims 6, 12 and 18, Shamoon teaches an agreement to pay a fee causes the display of only a non-text image from the single web page (multimedia stream is an image, as for the fee, Par. 349, et seq.).

Claims 23, 31 and 39, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shamoon et al., US Patent Publication 2004/0107356, and further in view of Mitchell, US Patent 6701350.

Shamoon teaches a script in the header and parsing the script from the script header to generate at the user device a display of the multiple offers (Par. 76 et seq.). Shamoon fails to teach XML as recited in the claims. In the same field of the invention, Mitchell teaches a web page display mechanism similar to that of Shamoon. In addition, Mitchell further teaches an XML script in the header and parsing the script from the script header to generate at the user device a display of the multiple offers (Col. 2, line 60 et seq.). It would have been obvious to one of ordinary skill in the art, having the teachings of Shamoon and Mitchell before him at the time the invention was made, to modify the requesting of a single web page, and according to a parsed header script, generate a display of differently priced options pertaining to a portion of the single web page, selecting an option, retrieving and displaying the corresponding portion of the single web page taught by Shamoon to include the XML header of Mitchell, in order to obtain implementation of the header execution in order to display different priced options to the user for viewing a portion of web page content. One would have been motivated to make such a combination because a universally accepted, web browser

compatible header for the invention would have been obtained, as taught by Mitchell (Col. 2, lines 60 et seq.).

(10) Response to Argument

Shamoon teaches using particular rules to access and use content (Par [0475]), "Rules 2705 applicable to a single work and/or works" (Par [390]). Shamoon teaches obtaining the content from a website (Par [0239]), and that the rules are stored within the content's subject header separate from the URL portion (Fig. 7). Shamoon shows that the user can view the work with advertisements for a low fee but must pay higher for viewing the same work without advertisements (Par [0349]) and the user can select one of these options from a menu displayed to the user (Par [0350]).

In response to the applicant's arguments regarding the limitation of independent claims 1, 7, 13, 19, 27 and 35 of displaying "a single web page", the examiner disagrees. Shamoon teaches selection of a priced option to display of a single web page with or without advertisements (Par [0349-0350]). As seen in Par [0239], the object, or webpage, is disclosed to be presented as a whole in accordance with it's corresponding rules that govern the webpage object. "Each object" recited in this paragraph refers to the website. Teachings regarding a MP3 file or streamed file represent alternate embodiments within Shamoon (Par [248]). "or Elementary Stream" recited in this paragraph refers to the alternate embodiment.

In response to the applicant's arguments regarding the limitation of dependent claims 3, 9, 15, 21, 29 and 37, of pricing options based on an "age" of the web page content, the examiner disagrees. Age is a period of existence. Shamoon teaches a priced option based on how long the programming exists (i.e. 12 hours). See rejection *supra.*

In response to the applicant's arguments regarding the limitation of dependent claim 22, of "multiple offers are defined by a non-URL descriptive portion of a script header to the web page content", the examiner disagrees. Offers are a part of the rules section of the header and can be seen in Figure 7 of Shamoon as separate from the URL descriptive portion.

In response to the applicant's arguments regarding the limitation of dependent claims 6, 12 and 18, of "an agreement to pay a fee causes the display of only a non-text image from the single web page", the examiner disagrees. First of all, the limitation "only a non-text image" has been rejected under 35 U.S.C. 112, first paragraph as failing to comply with the written description requirement. The specification simply recites an image with no teachings concerning only non-text.

Furthermore, the "Apellants submit that 'image' is a 'non-text image' " in accordance with a recited definition of the term image that states "an imitation or representation of a person or thing, drawn, painted, photographed, etc.". However the definition does not support inclusion of "non-text", in fact the use of the term "etc." could be text in the case of a PDF file. What is a PDF file if it is not an image of text? What happens when you scan a document with text? You have an image of text.

Regardless of the 35 U.S.C. 112, first paragraph, in accordance with claims 6, 12 and 18, Shamoon teaches that the user can agree to pay a higher fee to view an picture or audio stream without advertisements (Par [0349]).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Sara M. Hanne

Conferees:

Ba Huynh

Primary Examiner

AU 2179

BA HUYNH
PRIMARY EXAMINER

Weilun Lo

Supervisory Patent Examiner

AU 2179

WEILUN LO
SUPERVISORY PATENT EXAMINER

Kristine Kincaid

Supervisory Patent Examiner

AU 2174

KRISTINE KINCAID
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100